UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,689	12/03/1999	VIVEK KAPIL	NORT-0010-US	4098

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DAN C HU
TROP PRUNER HU & MILES PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER
WINDER, PATRICE L

ART UNIT	PAPER NUMBER
2145	25

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Appeal Brief filed on 10 May 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,19-24,27-30 and 32-42* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,19-24,27-30 and 32-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   In view of the Appeal Brief filed on May 10, 2004, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-4, 8, 19-24, 27-28, 30, 33, 35, 37, 39, 41 are rejected under 35

U.S.C. 102(e) as being anticipated by Aggarwal et al., USPN 6,415,318 B1 (hereafter

referred to as Aggarwal) with Aggarwal et al., USPN 5,943,478 (hereafter referred to as

Aggawal_2) incorporated by reference.

4.   Regarding claim 1, Aggarwal taught a method of communicating in a network

having a plurality of communities each including a server (column 6, lines 41-45, column

7, lines 28-34), comprising:

receiving from the server in a first community associated with a first service

provider, a request indicating desired real-time, text-based messaging from a first

community server to a second terminal coupled to the server in a second community

associated with a different service provider (column 8, lines 56-59, column 9, lines 60-

65); and

processing the request, by the server in the second community, to establish a

real-time, text-based messaging session between the first and second terminals through

the first and second community servers (column 9, lines 60-65).

5.   Regarding dependent claim 2, Aggarwal taught the method further comprising

determining if the second terminal has an established link with the second community

server (column 9, lines 60-62).

6.   Regarding dependent claim 3, Aggarwal taught the method further comprising

sending a notification to the second terminal of the desired messaging session if the

second terminal has an established link with the second community server (column 9,

lines 66-67).

7.   Regarding dependent claim 4, Aggarwal taught the method further comprising

receiving an indication from the second terminal of whether the desired messaging

session has been accepted (column 10, lines 10-13).

8.   Regarding dependent claim 8, Aggarwal taught the method further comprising

establishing a chat session between the first and second terminals (column 10, lines 49-

53).

9.   Regarding claim 19, Aggarwal taught a server for use in a communications

system having a plurality of communities coupled by a network (column 6, lines 40-45),

each community associated with a different service provider (column 7, lines 28-34), the

server being associated with a first one of the communities and comprising:

        an interface unit adapted to receive a contact request over the network from an

entity associated with another community, the entity not logged on to the server (column

7, lines 39-44), the contact request indicating a request to establish a text-based

messaging session with a destination terminal linked to the server (column 9, lines 60-

65); and

        a controller adapted to send a notification to the destination terminal of the

contact request (column 9, lines 66-67) and receive an indication from the destination

terminal of acceptance of the contact request (column 10, lines 10-13).

10.   Regarding claim 20, Aggarwal taught an article including one or more machine-

readable storage media containing instructions for establishing a text-based messaging

session between subscribers in a plurality of communities (column 6, lines 40-45), each

community associated with a different service provider (column 7, lines 28-34), the

instructions when executed causing a system in a first community associated with a first

service provider to:

receive a request from a subscriber in a second community associated with a

second service provider, the request indicating a desired text-based messaging session

with a subscriber in the first community (column 8, lines 56-59, column 9, lines 60-65);

notify the subscriber in the first community of the request (column 9, lines 60-65);

determine if the subscriber in the first community has accepted the request

(column 10, lines 10-13); and

establish the text-based messaging session between the subscribers if the

subscriber in the first community accepted (column 10, lines 23-26).

11.   Regarding dependent claim 21, Aggarwal taught the one or more storage media

contain instructions that when executed cause the system to further send signaling to

establish the text-based messaging session (column 9, lines 66-67).

12.   Regarding dependent claim 22, Aggarwal taught the text-based messaging

session includes a chat session (column 10, lines 23-26).

13.   Regarding dependent claim 23, Aggarwal taught the one or more storage media

contain instructions that when executed cause the system to create a controller object

adapted to control the text-based messaging session (column 10,lines 1-7).

14.   Regarding dependent claim 24, Aggarwal taught the one or more storage media

contain instructions that when executed cause the system to: receive a request from a

subscriber in a third community associated with a third service provider for a text-based

messaging session (column 6, lines 45-48, column 7, lines 25-27); and

establish the text-based messaging session among the subscribers in the first,

second, and third communities (column 10, lines 49-53).

15.   Regarding dependent claim 27, Aggarwal taught receiving the request comprises

receiving a request indicating a desired interactive, text-based chat session (column 8,

lines 56-59, column 9, lines 60-65, column 10, lines 23-26).

16.   Regarding dependent claim 28, Aggarwal taught the text-based messaging

session comprises an interactive, text-based chat session (column 10, lines 23-26).

17.   Regarding dependent claim 30, Aggarwal taught the instructions when executed

cause the system to establish the text-based messaging session by establishing an

interactive, text-based chat session (column 10, lines 23-26).

18.   Regarding dependent claim 33, Aggarwal taught providing a session object in the

second community server, wherein receiving the request comprises receiving a request

at the session object in the second community server from another session object in the

first community server (column 5, lines 5-8, column 9, lines 60-62); and

the session object in the second community server exchanging messaging with

the first community server to establish the real-time, text-based messaging session

(column 10, lines 23-26).

19.   Regarding dependent claim 35, Aggarwal taught the interface unit is adapted to

receive the contact request from a second server in the other community (column 9,

lines 24-28, 44-56, 60-62).

20.   Regarding dependent claim 37, Aggarwal taught the controller comprises a

session object (column 5, lines 5-8), the session object adapted to exchange messaging

with another session object in a second server in the other community to establish the

text-based messaging session (column 10, lines 23-26).

21.   Regarding dependent claim 39, Aggarwal taught the instructions when executed

cause the system to receive the request at a first server in the system from a second

server in the second community (column 9, lines 60-65).

22.   Regarding dependent claim 41, Aggarwal taught the instructions when executed

cause the system to: provide a session object in the system (column 5, lines 5-8,

column 9, lines 60-62); and

cause the session object to exchange messaging with the second server to

establish the text-based messaging session (column 10, lines 23-26).

Claim Rejections - 35 USC § 103

23.   The text of those sections of Title 35, U.S. Code 103(a)not included in this action

can be found in a prior Office action.

24.   Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Aggarwal in view of Ogle et al., USPN 6,430,604 B1 (hereafter referred to as Ogle).

25.   Regarding dependent claim 5, Aggarwal does not specifically teach sending a

message to a predetermined communications device other than the second terminal if

the second terminal does not have an established connection with the second

community server. However, Ogle taught sending a message to predetermined

communications device other than the second terminal if the second terminal does not

have an established connection with the second community server (instant messaging

system 403, column 9, lines 22-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Ogle's predetermined communications device in Aggarwal's instant messaging system would have improved system responsiveness. The motivation would have been to use an alternative message delivery system for users not currently logged in (column 2, lines 47-52).

26.   Regarding dependent claim 6, Ogle taught sending the messages includes sending to a communications device including at least one of a telephone, a pager and an electronic mail receiver (column 9, lines 40-47).

27.   Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal as applied to claims 2 and 19, respectively, further in view of Ishikawa, USPN 6,038,602 (hereafter referred to as Ishikawa).

28.   Regarding dependent claim 7, Aggarwal does not specifically teach performing a reverse log on to the second terminal if the second terminal does not have an established link with the second community server. However, Ishikawa taught performing a reverse logon to the second terminal if the second terminal does not have an established link with the second community server (column 10, lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Ishikawa's reverse logon in Aggarwal's instant messaging system would have extended system functionality. The motivation would have been to eliminate the necessity for arranging network connections in advance (column 2, lines 64-67).

29.   Regarding dependent claim 29, Aggarwal does not specifically teach the controller is adapted to further send messaging to perform a reverse log-on procedure

with the destination terminal. However, Ishikawa taught the controller is adapted to further send messaging to perform a reverse log-on procedure with the destination terminal (column 10, lines 5-25). For motivation for combination see claim 7, above.

30.   Claims 32, 34, 36, 38, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Auerbach as applied to claims 1, 19, and 39, further in view of Busey et al., USPN 5,764,916 (hereafter referred to as Busey).

31.   Regarding dependent claim 32, Aggarwal taught providing a window for display at the first terminal, wherein receiving the request comprises receiving a message generated in response to a selection made in the window (column 9, line 66 – column 10, line 7). Aggarwal does not specifically teach the window is a web page. However, Busey taught the window is a web page (column 1, lines 26-34, column 4, line 66 – column 5,line 38).

32.   Regarding dependent claim 34, Aggarwal taught providing a response, from the second community server, to the first terminal to present a window in a graphical user interface on the first terminal (column 9, lines 66-67); and

receiving a text message of the real-time, text-based messaging session originated from the window on the first terminal (column 10, lines 10-13, 23-26). Aggarwal does not specifically teach the window is a web page and the graphical user interface is a web browser. However, Busey taught the window is a web page and the graphical user interface is a web browser (column 1, lines 26-34, column 4, line 66 – column 5,line 38).

33.   Regarding dependent claim 36, Aggarwal taught the controller is adapted to

communicate a window for display on the entity, the contact request comprising a

message generated in response to user selection made in the window at the entity

(column 9, line 66 – column 10, line 7). Aggarwal does not specifically teach the window

is a web page. However, Busey taught the window is a web page (column 1, lines 26-

34, column 4, line 66 – column 5,line 38).

34.   Regarding dependent claim 38, Aggarwal taught the controller is adapted to

communicate a response to the contact request to present a window in a graphical user

interface at the entity (column 9, lines 66-67), the interface unit adapted to further

receive text messaging from the graphical user interface at the entity during the text-

based message session (column 10, lines 10-13, 23-26). Aggarwal does not specifically

teach the window is a web page and the graphical user interface is a web browser.

However, Busey taught the window is a web page and the graphical user interface is a

web browser (column 1, lines 26-34, column 4, line 66 – column 5,line 38).

35.   Regarding dependent claim 40, Aggarwal taught the instructions when executed

cause the system to provide a window for display at a subscriber terminal in the second

community (column 9, lines 66-67), wherein the request received at the first server

comprises messaging generated in response to selection made in the window displayed

at the subscriber terminal in the second community (column 10, lines 1-7). Aggarwal

does not specifically teach the window is a web page. However, Busey taught the

window is a web page (column 1, lines 26-34, column 4, line 66 – column 5,line 38).

36.   Regarding dependent claim 42, Aggarwal taught the instructions when executed cause the system to: communicate, in response to the request, a window for display in a graphical user interface at a subscriber terminal in the second community (column 9, lines 66-67); and

receive messaging from the graphical user interface during the text-based messaging session (column 10, lines 1-7, 10-13). Aggarwal does not specifically teach the window is a web page and the graphical user interface is a web browser. However, Busey taught the window is a web page and the graphical user interface is a web browser (column 1, lines 26-34, column 4, line 66 – column 5,line 38).

37.   It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Busey's web page and web browser in Aggarwal's instant messaging system would have improved system effectiveness. The motivation would have to provide an avenue for widespread use of Aggarwal's instant messaging system (column 2, lines 43-46).

Conclusion

38.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-3662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Patrice Winder
Patrice Winder
Primary Examiner
Art Unit 2145

July 26, 2004